

REMARKS

Claims 1-68 are pending in this application. Claims 7-52 are withdrawn from consideration. Claims 1-6 and 53-68 are rejected. Claims 1, 53, 64 and 67 are independent claims.

The examiner continues to reject claims 1-6 and 53-63 as directed to non-statutory subject matter. The examiner states that the PTO's position, following the guidance of the Board of Patent Appeals, is that each claimed method directed to class 705 must include reference to a computer in the preamble as well as in the body of the claims.

Applicants respectfully disagree and point out to the examiner that statutory subject matter is not governed by the Board of Patent Appeals, but by Title 35 and its interpretation by Article III courts of the United States. Applicants have amended claim 1 to recite, in part, "a method of detecting alert conditions in a plurality of networked computer systems comprising: receiving a message in one of the plurality of networked computer systems for a new quote for a trading item." Applicants have amended claim 53 to recite, in part, "a method comprising: in a network of interconnected computer systems, receiving a message in a network server for a new quote for a trading item."

Accordingly, claims 1 and 53, as amended, are directed toward statutory subject matter under 35 U.S.C. §101 and the examiner's rejection should be withdrawn.

The examiner continues to reject claims 1-6 and 53-63 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter that applicants regard as the invention. More specifically, the examiner argues that the PTO position is that "system" and "network" are indefinite without some accompanying structure.

Applicants are bewildered. One skilled in this art would clearly identify and recognize a system and a network for what they are. Applicants have amended claim 1, in part, to recite "a method of detecting alert conditions in a plurality of networked computer systems comprising: receiving a message in one of the plurality of networked computer systems for a new quote for a

trading item.” Applicants have amended claim 53, in part, to recite “a method comprising: in a network of interconnected computer systems, receiving a message in a network server for a new quote for a trading item.”

The examiner continues to reject claims 1-6 and 53-68 as having been anticipated by the CNET news.com article. Maintaining a position stated in an earlier office action, the examiner argues that “a rejection under 35 U.S.C. §102/103 can be made when the prior art product seems identical to that of the prior art except that it is silent to an inherent characteristic.”

Applicants disagree. In order for a reference to inherently anticipate under §102, following the reference must inevitably produce the claimed subject matter. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The mere fact that a reference’s generically disclosed structure might fortuitously have been built in accordance with the narrower limitations of the claim cannot constitute anticipation. In re Felton (cited by the CCPA in In re Marshall, 578 F.2d 301, 198 USPQ 344 (CCPA 1978)); Tilghman v. Proctor, 102 U.S. 707 (1880); Eibel Process Co. v. Minnesota and Ontario Paper Co., 261 U.S. 45 (1923).

Claim 1 recites “receiving a message in one of the plurality of networked computer systems for a new quote for a trading item.” The CNET news.com article neither describes nor suggests this quoted feature. On the contrary, the CNET news.com article discloses monitoring the market’s billions of transactions. Claim 1 recites, “comparing the new quote to one or more existing quotes for the same item.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 1 recites, “transmitting an alert message in response to comparing if the new quote causes a locked or crossed market condition.” The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 1 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

Claim 53 recites, “in a network of interconnected computer systems, receiving a message in a network server for a new quote for a trading item.” The CNET news.com article neither describes nor suggests this quoted feature. Claim 53 recites, “comparing the new quote to existing quotes for the same trading item.” The CNET news.com article neither describes nor

suggests this quoted feature. Claim 53 recites "generating an alert if the new quote is determined to represent a usual quote value." The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 53 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

Claim 64 recites, "receive a message for a new quote for a trading item." The CNET news.com article neither describes nor suggests this quoted feature. Claim 64 recites, "compare the new quote to one or more existing quotes for the same item." The CNET news.com article neither describes nor suggests this quoted feature. Claim 64 recites, "transmit an alert message in response to comparing if the new quote causes a locked or crossed market condition." The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 64 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

Claim 67 recites, "receive a message in a network server for a new quote for a trading item." The CNET news.com article neither describes nor suggests this quoted feature. Claim 67 recites, "compare the new quote to existing quotes for the same trading." The CNET news.com article neither describes nor suggests this quoted feature. Claim 67 recites "generate an alert if the new quote is determined to represent an usual quote value." The CNET news.com article neither describes nor suggests this quoted feature.

Accordingly, claim 67 is not anticipated by the CNET news.com article and the rejection under 35 U.S.C. §102(e) is improper and should be withdrawn.

The examiner continues to reject claims 1-6 and 53-68 as having been obvious in view of the CNET news.com article. As stated above, the examiner argues that "a rejection under 35 U.S.C. §102/103 can be made when the prior art product seems identical to that of the prior art except that it is silent to an inherent characteristic." The examiner's basis for obviousness appears to be inherency.

Applicants disagree. In going from the prior art to the claimed invention one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather must consider what the prior art would have led a person skilled in the art to do.

In a prior office action, the examiner admits that claim 1 fails to teach an alert for a market condition known as "locked or crossed." Claim 1 also recites "receiving a message in one of the plurality of networked computer systems for a new quote for a trading item." This feature is not disclosed, suggested or taught in the CNET news.com article, and thus claim 1, as amended, would not have been obvious from the CNET news.com article. The CNET news.com article only discloses the following and nothing else:

the software monitors the market's billions of transactions and alerts Nasdaq officials to any unusual market activity. (paragraph two)

One skilled in this art recognizes a transaction as an agreement between a buyer and a seller to exchange an asset for payment. This is different from receiving a message in one of the plurality of networked computer systems for a new quote for a trading item. Accordingly, claim 1 is not rendered obvious by the CNET news.com article.

Claims 53, 64 and 67 recite "in a network of interconnected computer systems, receiving a message in a network server for a new quote for a trading item, comparing the new quote to existing quotes for the same trading item," or similar language. The feature is not disclosed, suggested or taught in the CNET news.com article, and thus claims 53, 64 and 67 would not have been obvious from the CNET news.com article.

All of the dependent claims are patentable for at least the same reasons as the claims on which they depend.

The applicants' discussion of particular arguments of the Examiner should not be construed as a concession by the applicants with respect to any other positions of the Examiner. The applicants' assertion of arguments for patentability of certain claims should not be construed as suggesting that there are not also other good reasons why those or other claims are patentable.

Applicants ask that all claims be allowed. Please apply any charges or credits to deposit account 06-1050.

Applicant : Ana Gabriela Anaya et al.
Serial No. : 09/347,497
Filed : July 2, 1999
Page : 10 of 10

Attorney's Docket No.: 09857-022001

Respectfully submitted,

Date:

January 26, 2004

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20785014.doc



Kenneth F. Kozik
Reg. No. 36,572